

REMARKS

Reconsideration of the rejections set forth in the Office Action mailed December 21, 2005, is respectfully requested. Claims 1-23, 25, 27-29, and 32 have been cancelled without prejudice. Claims 24, 26, and 30-31 remain pending.

Information Disclosure Statement

Applicants have listed the foreign patent and non-patent literature references that were not considered in the Information Disclosure Statement filed July 25, 2003 on the PTO/SB/08b with the Information Disclosure Statement filed herewith. Copies of the foreign patent and non-patent literature references are included herewith.

Claim Objections

Claims 2, 8, 11, 20, and 29 contained objections for various informalities. Without conceding the propriety of these rejections, these claims have been cancelled. Therefore, the objections to these claims are now moot.

35 U.S.C. § 112

Claims 2-14, 20, and 29 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Without conceding the propriety of these rejections, these claims have been cancelled without prejudice. Therefore, the rejections to these claims are now moot.

Claims 4, 8, 16, 20, 25, and 29 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Without conceding the propriety of these rejections, these claims have been cancelled without prejudice. Therefore, the rejections to these claims are now moot.

Claim 11 was rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Without conceding the propriety of this rejection, this claim has been cancelled without prejudice. Therefore, the rejection to this claim is now moot.

Claims 13 and 22 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Without conceding the propriety of these rejections, these claims have been cancelled without prejudice. Therefore, the rejections to these claims are now moot.

Claims 14, 23, and 32 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Without conceding the propriety of these rejections, these claims have been cancelled without prejudice. Therefore, the rejections to these claims are now moot.

Art Rejections

Claims 2-5, 8, 9, 24-26, and 29-32 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Cragg et al. (USP 6,071,301). Claims 2-5, 8, 9, 25, 29, and 32 were cancelled. Therefore, the rejections to these claims are now moot. With respect to claims 24, 26, and 30-31, these claims were substantially copied from Burbank et al., USP 6,427,081 (the '081 patent) for the purposes of provoking an interference. The '081 patent has a priority date of not earlier than

February 2, 1999. Therefore, these rejections over Cragg et al., which has a priority date of not earlier than May 1, 1998, are equally applicable to the '081 patent. The Examiner's refusal to allow Applicants' claims over the Cragg '301 patent is arbitrary and capricious. The Court of Appeals for the D.C. Circuit has repeatedly held that "an agency must treat similar cases in a similar manner unless it can provide a legitimate reason for failing to do so." *Independent Petroleum Association of America v. Babbitt*, 92 F.3d 1248, 1258 (D.C.Cir.1996) (citing *National Association of Broadcasters v. FCC*, 740 F.2d 1190, 1201 (D.C.Cir.1984)) "Government is at its most arbitrary when it treats similarly situated people differently." *Etelson v. Office of Personnel Management*, 684 F.2d 918, 926 (D.C. Cir. 1982). "If an agency treats similarly situated parties differently, its action is arbitrary and capricious in violation of the APA." *Allergan, Inc. v. Shalala*, 6 Food and Drug Rep. 389, 391, No. 94-1223 (D.D.C. Nov. 10, 1994) (Greene, J.).

In this case, Applicants are "similarly situated" to Burbank et al. in that both Applicants and Burbank et al. have priority dates after the earliest priority date of Cragg et al., the primary art reference at issue. Yet, in contrast to the prosecution of the current application, the '081 patent was allowed over the Cragg patent. Due to the arbitrary treatment of the current application, Applicants are prevented from challenging various claims of the '081 patent in an interference proceeding. Therefore, Applicants respectfully request withdrawal of the rejections and reconsideration of the claims.

Furthermore, it is respectfully urged that the Examiner's rejection of the claims is improper under MPEP § 2307.2. If the rejection of the Applicants' claims is equally applicable to the claims of the '081 patent, which it is, then it is respectfully urged that the rejection requires approval of the Group Director under MPEP 2307.02.

Claims 15-21 and 23 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Stinson (USP 6,174,330). Without conceding the propriety of these rejections, these claims have been cancelled without prejudice. Therefore, the rejections to these claims are now moot.

Claims 6, 7, 27, and 28 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Cragg et al. in view of Stinson. Without conceding the propriety of these rejections, these claims have been cancelled without prejudice. Therefore, the rejections to these claims are now moot.

Claims 10-13 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Cragg et al. in view of Unger et al. (USP 6,231,834). Without conceding the propriety of these rejections, these claims have been cancelled without prejudice. Therefore, the rejections to these claims are now moot.

Claim 14 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Cragg et al. in view of Unger et al. and further in view of Stinson. Without conceding the propriety of this rejection, this claim has been cancelled without prejudice. Therefore, the rejection to this claim is now moot.

Claim 1 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Cragg et al. in view of Unger et al. Without conceding the propriety of this rejection, this claim has been cancelled without prejudice. Therefore, the rejection to this claim is now moot.

Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact Applicant's undersigned representative at (949) 760-9600. The

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Commissioner is hereby authorized to charge any additional fees that may be required to Deposit
Account No. 50-2862.

Respectfully submitted,

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